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| BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510 | | | ARYANPOUR, MITRA | |
| | | | ART UNIT | PAPER NUMBER |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/720,948
Filing Date: November 24, 2003
Appellant(s): GAGNON, PAUL R.

**MAILED
DEC 08 2005
Group 3700**

Paul R. Gagnon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 October 2005 appealing from the Office action mailed 10 May 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------------|---------------|---------|
| 4,719,909 | Micchia et al | 1-1998 |
| 4,951,658 | Morgan et al. | 8-1990 |
| WO 96/32979A1 | Maged | 10-1996 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Maged (WO 96/32979 A1).

Regarding claim 1, Maged discloses a piece of material (article 10 having two members 101 and 102) having a thickness (as best seen in figure 2b, the members have a thickness), said piece of material having an adhesive coating or layer (layer of adhesive 101b (102b)) for positioning said piece of material on a portion of an individual's face (see figure 2a). The thickness of the material is sufficient to interfere with an individual's ability to look in a specific direction at an object such as a sporting object (see page 4, lines 25-31 and page 5, lines 1-7). It should be noted that the preamble, *a sports vision training device*, does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. It is noted that the thickness of Maged's piece of material inherently interferes with said individual's ability to look at any object including a sports object.

Regarding claim 2, Maged in figure 2b shows the piece of material has a thickness, the thickness being sufficient to direct the individual's vision up and toward the field of play and players on said field of play (page 5, lines 1-7).

Additionally:

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Claims 1-4, 6, 9-12, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Micchia et al (4,719,909).

Regarding claim 1, Micchia et al discloses a piece of material (patch 7) having a thickness (as best seen in figure 2, the patch has a thickness), said piece of material having an adhesive coating or layer (adhesive layer 13) for positioning said piece of material on a portion of an individual's face (see figure 1); the thickness of the material is sufficient to interfere with an individual's ability to look in a specific direction at a sporting object (column 2, lines 14-45). It is noted that the thickness of Micchia et al's piece of material inherently interferes with said individual's ability to look at any object including a sports objection.

Regarding claim 2, Micchia et al shows in figure 2, the piece of material has a thickness, the thickness being sufficient to inherently direct the individual's vision up and toward the field of play and players on said field of play.

Regarding claim 3, Micchia et al shows said piece of material (patch 7) is formed from a porous material (see column 2, lines 22-27) on one side and a pliable sheet material such as medical adhesive bandages on the opposite side (see column 2, lines 28-36). It is noted that the commonly used and well-known medical adhesive bandages are formed from open-cell foam material.

Regarding claim 4, Micchia et al shows said adhesive coating or layer includes means for absorbing moisture and for transferring said moisture from a surface of an individual's skin to the piece of material to allow the moisture to evaporate (see column 3, lines 38-42).

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Regarding claim 6, Micchia et al shows said piece of material (patch 7) has an upper surface (light absorbing surface 12) and said upper surface is intermittently grooved (see figure 2; also see column 2, lines 46-55) to permit momentary glances at said sports object.

Regarding claim 9, Micchia et al shows said device is disposable (see column 3, lines 35-37).

Regarding claim 10, note the rejection of claims 1, 2 and 9.

Regarding claim 11, note the rejection of claim 3.

Regarding claim 12, note the rejection of claim 4.

Regarding claim 14, note the rejection of claim 6.

Regarding claim 15, Micchia et al shows said vision restriction devices are attached to an individual's face along side each eye to inherently restrict the individual's peripheral vision (see figure 1).

Regarding claim 16, note the rejection of claim 3.

Regarding claim 18, during normal use and operation of the Micchia et al device, the method step set forth by applicant in the claim is inherently provided.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al (4,719,909).

Regarding claims 7 and 8, Micchia et al does not disclose expressly the addition of indicia or logo on the upper surface of the piece of material. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to include indicia or logo on the upper surface of the piece of material, because Applicant has not disclosed that the inclusion of indicia or logo, provides an advantage, is used for a particular

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purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the piece of material taught by Micchia et al or the claimed piece of material because both material perform the same function of improving under-eye light absorbing device which can be easily applied and easily stripped in one piece as desired. Therefore, it would have been an obvious matter of design choice to modify Micchia et al to obtain the invention as specified in claims 7 and 8.

Claims 5, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al (4,719,909) in view of Morgan et al (4,951,658).

Regarding claim 5, Micchia et al does not disclose expressly that the moisture absorbing and transferring means comprises a hydrocolloidal material incorporated into the adhesive layer. Morgan et al shows the use of hydrocolloidal material incorporated into the adhesive layer. Morgan et al teaches that hydrocolloidal materials have indeed been used successfully for many years by general surgeons and internists to cover burns, pressure sores and wounds. Morgan et al further teaches that the presence of the hydrocolloidal material with the pressure sensitive adhesive assures that the patch can remain in place for an extended period, without the adhesive bond being so weakened by sweat or other moisture that it could only hold the patch in place for the short period of time in which the adhesive of known patches are effective. Furthermore, the hydrocolloidal material draws moisture away from the interface between the adhesive and the skin, avoiding the problems of skin rashes and trauma to the skin upon removal of the patch. In view of the teachings of Morgan et al it would have been obvious to incorporate hydrocolloidal material in the adhesive layer of Micchia et al, the motivation being to strengthen the adhesive

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bond and to draw moisture away from the interface between the adhesive and the skin, avoiding the problems of skin rashes and trauma to the skin upon removal of the patch.

Regarding claim 13, note the rejection of claims 4 and 5.

Regarding claim 17, note the rejection of claim 5.

(10) Response to Argument

With regards to appellant's assertion that neither Maged nor Micchia et al show the piece of material having a thickness sufficient to interfere with an individual's ability to look in a specific direction at a sporting object when controlled by an individual. The claims as presented do not require the material to have a specific thickness. The claims merely requires the material to have a thickness sufficient to interfere with... Again the claim does not require the thickness to be in a specific range. Both references show the material to have sufficient thickness, this is clearly demonstrated in the drawings. Since no specific thickness has been claimed, then the thickness of the material in both the Maged and Micchia et al patent can be considered "sufficient" to interfere with the user's ability to look in a specific direction. Applicant is merely suggesting that the thickness of the material will cause interference. Any material positioned under the eyes will cause some degree of interference with the field of vision, whether it is in a sporting environment or any other environment. Appellant merely asserts that the Maged and Micchia et al patents do not have the same thickness claimed. However, no thickness has been claimed. Since the claims as presented do not provide a specified thickness or a desired thickness range that would yield to unexpected results, then the question arises as to what actually constitutes "sufficient" and if one particular thickness is sufficient for all users, or does the thickness need to be adjusted to effectively aid the user. Therefor, as can be seen the mere use of

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the term “sufficient” does not readily yield to the conclusion that the thickness should be greater than what has been disclosed in the prior art. As appellant has pointed out the Maged patent is silent with respect to the thickness of the material. From Figure 2B it appears that the material has substantial thickness. Again the same is true for the Micchia et al patent, it discloses the shape, the length and width but not the thickness. Therefore, to reach the conclusion that neither patent has the same thickness because it hasn’t been expressly disclosed is not persuasive since it is speculative and is not supported by any objective evidence. In re DeBlauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

Regarding appellant’s assertion that it is not true that the material of Micchia et al would perform equally well with indicia or logo. It is unclear how applicant has reached such a conclusion, since the use of indicia or logo is not uncommon in the sporting environment. Comiskey et al clearly teaches the use of indicia. Comiskey et al shows the indicia can be color, letters or figures. Appellant has not disclosed that providing indicia on the material yields to unexpected results. Again appellant assertions are merely speculative and not supported by any objective evidence. More over appellant has not defined the metes and bounds of what constitutes indicia or logo. Therefore, in the instant case, the color black can be considered the indicia and/or logo.

As indicate above the use of hydrocolloidal material incorporated into an adhesive layer is old and well known. This is also taught by Morgan et al. Morgan et al teaches that hydrocolloidal materials have indeed been used successfully for many years by general surgeons and internists to cover burns, pressure sores and wounds. The presence of the hydrocolloidal

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material with the pressure sensitive adhesive assures that the patch can remain in place for an extended period, without the adhesive bond being so weakened by sweat or other moisture that it could only hold the patch in place for the short period of time in which the adhesive of known patches are effective. Furthermore, the hydrocolloidal material draws moisture away from the interface between the adhesive and the skin, avoiding the problems of skin rashes and trauma to the skin upon removal of the patch. In conclusion, appellant is claiming what is old and well know.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

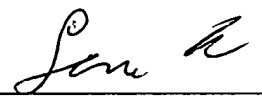
Respectfully submitted,

Mitra Aryanpour

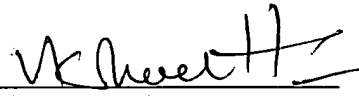


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